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No. - .

In the
Supreme Court of the United States.

OCTOBER TERM, 1983.

RAYTHEON COMPANY,
PETITIONER,

v.

ROPER CORPORATION,
RESPONDENT.

Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit.

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Petitioner, Raytheon Company, respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit entered in this proceeding on December 30, 1983.

QUESTIONS PRESENTED

I. May a patented apparatus be found to have "utility" within the meaning of 35 U.S.C. §§ 101 and 112 where that apparatus is wholly inoperative with respect to the problem which it assertedly solved?

As corollaries to this:

A. May claims to an invention which assertedly achieves an unusual and surprising result be invalidated on a showing of complete failure to achieve that result only when the

result itself is expressly stated in the claims?

B. May a patent be found to have utility under 35 U.S.C. §§ 101, 112 if it possesses utility for some purpose even if that purpose is not the purpose for which the patent was granted?

C. May a court define "the invention" for which a patent was granted solely as a matter of law and without regard to factual evidence concerning the invention and the nature in which it operates?

D. Where a patentee tried its case on the theory that its invention provided certain "surprising results" and the Trial Court, after hearing all the testimony and viewing tests conducted by both parties, found it "inescapable" that

such results were not, in fact, achieved, may the Court of Appeals sua sponte redefine both the invention and the theory on which the case was tried so as to ignore the failure to achieve such results?

II. May a court ignore the statements contained in the explanatory portion of a patent (i.e., the specification), which place in context terms used in the claims, when determining the scope of those claims?

III. May a patent whose claims would otherwise be invalid for lack of utility (35 U.S.C. § 101) nevertheless be upheld by a court because the court refuses to consider such lack of utility once it finds the patent infringed?

IV. May the Court of Appeals for the Federal Circuit set aside the Trial Court's findings as to the nature and operation of the patented invention without regard to the "clearly erroneous" standard of F.R.Civ.P. 52(a) where the findings were supported by the overwhelming weight of both the testimonial and documentary evidence.

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OPINIONS BELOW

The opinion of the United States District Court for the District of Massachusetts is unreported but has been reproduced in the Appendix to this petition at App. B1 - B59.* The opinion of the Court of Appeals for the Federal Circuit is reported at 724 F.2d 951 and 220 U.S.P.Q. 592 and is reproduced at Appendix pages App. B60-B124.

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*The appendix to this Petition is presented in two volumes, labelled Volume A and Volume B, respectively. Volume A is oversized, as it contains patent documents. Pages of the appendix are referred to in the form "App. Xy," where X indicates the volume (i.e., A or B) and y denotes a page number within that volume.

The patent in suit has a "specification" (written description) common to three separate patent applications. To assist the Court, those portions of the specification specific to the invention in question here are highlighted in gray.

JURISDICTION

The U.S. District Court had original jurisdiction of this matter pursuant to 28 U.S.C. §§ 1338(a), 2201 and 2202. The judgment of the Court of Appeals for the Federal Circuit was entered on December 30, 1983. Petitioner's timely petition for rehearing was denied on March 1, 1984 and this petition for certiorari is being filed within 90 days of that date. A copy of the order denying the petition for rehearing is printed in the Appendix at page B125. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTES INVOLVED

35 U.S.C. § 101 states:

Whoever invents or discovers any new and useful process, machine, manufacture,

or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. § 103 states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C. § 112, first and second paragraphs, states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the

subject matter which the applicant regards as his invention.

FEDERAL RULE OF CIVIL PROCEDURE INVOLVED

Rule 52(a), F.R.Civ.P., states:

> In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of the law thereon, and judgment shall be entered pursuant to Rule 58; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. It will be sufficient if the findings of fact and conclusions of law are stated orally and recorded in open court following the close of the evidence or appear in an opinion or memorandum of decision filed by the court. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41(b).

STATEMENT OF THE CASE

In response to a letter charging it with infringement of United States Patent No. 4,028,520, issued June 7, 1977 to Sumner H. Torrey for "Air flow System For Common Cavity Microwave Oven" and assigned to the Roper Corporation ("Roper"), Raytheon Company ("Raytheon") brought suit in the United States District Court for the District of Massachusetts for a declaratory judgment of invalidity and non-infringement. After an eight-day trial, the court found the alleged invention to be inoperative and thus held the patent invalid under 35 U.S.C. §§ 101 and 112.

The Court of Appeals for the Federal Circuit affirmed the District Court's decision as to Claim 1. However, it reversed as to Claims 2-7, though they define the same oven structure as

Claim 1, because they use different language in describing the performance of that structure. (App. B81-B89).

The invention, which may be better understood by reading this description in conjunction with the diagram printed at App. B126, relates to so-called "common cavity" or "combination" ovens - i.e., ovens wherein food may be cooked thermally (e.g., using conventional electric resistance elements) and/or by microwaves within the same (i.e., common) cooking chamber or "cavity", and wherein the oven may also be operated in a conventional, pyrolytic self-cleaning mode. (App. B61-B62). In particular, the patented invention is purportedly directed to an improvement in such self-cleaning common-cavity ovens.

The invention covered by the patent in suit is an air flow system for such

ovens. (Col. 1, lines 1-2, 43-44, 48-49 and 55-56).*

Air is supplied to the oven cavity through a part of the microwave energy supply called a waveguide, by way of a hole in the bottom of the oven cavity. The waveguide is simply a metal tube. Microwave energy for cooking is transmitted from a microwave generator to the oven cavity through this tube. The microwave generator is located beneath the oven cavity (App. B67-B69), and the waveguide is connected between the microwave generator and the opening in the oven bottom. (App. B67-B69).

Two types of airflow are involved: during microwave cooking, a fan forces air through the waveguide tube and into

*References to the patent in suit, reproduced at App. A1-A13, will be to column and line, only, rather than to Appendix page, to facilitate location of the appropriate passages.

the oven cavity, to carry off the moisture released by microwave heating (App. B69); during thermal cooking and self-cleaning, the airflow into the oven is convective, being generated by the rising of hot air in the oven cavity. (App. B69).

During microwave operation, the airflow system is identical to that used previously for microwave ovens. (App. B138, B139). In conventional electric self-cleaning ovens, the convective air during cooking and self-cleaning enters through a gap at the bottom of the oven door (col. 7, line 32); in the patented oven, convection air flow during thermal operation passes into the cavity through the same path as is used for entry of forced air during microwave cooking (App. B69) as a natural consequence of locating

the entry point for forced air flow at the bottom of the cavity.

The problem alleged to be solved by the invention is the backing up of oven vapors into the waveguide, from the oven cavity, when the oven is operated in the self-cleaning mode. (Col. 1, lines 5-25). This back-up (also called backflow) was asserted by the inventor to cause fouling of the waveguide and thereby to be deleterious to operation of the microwave supply (App. B140-B141). It results from the increased pressure in the oven cavity caused by "auto-ignition" which accompanies self-cleaning (patent, col. 1, lines 5-25; col. 7, lines 22-33).* The solution of the backflow

*Autoignition is the spontaneous combustion of volatile gases from food residue that occurs from time to time during self-cleaning. The combustion is rapid, in the nature of an explosion, giving rise to a substantial pressure surge in the oven cavity. (App. B142-B143)

problem is the stated goal of the invention is set forth expressly in each of the specific objects recited in the patent (col. 1, lines 26-54) and implicitly in the sole "general" object (col. 1, lines 55-59).

The problem supposedly was solved by placing the open waveguide below the oven cavity (col. 7, lines 22-33) instead of on the sidewalls (as in the prior Boehm patent, App. A23) or on the top as in prior wall-mounted or countertop ovens (e.g., Roper's prior Tingley patent, App. A17, and Raytheon's Amana RR4 oven, App. B127, B144-B147). This was asserted to provide a continuous upward flow of air through the oven cavity and out the vent at the top, even in the face of the pressures developed by autoignition, so that back-up of decomposition products into the waveguide is thereby prevented

(col. 7, lines 22-33). This structure (i.e., placement of an open waveguide below the oven cavity, with convective air flowing through it during self-cleaning) purportedly solved the backflow problem and was incorporated in every claim of the patent.

At trial, Raytheon established that both the Roper and the Raytheon ovens (the one being asserted to embody the patented invention, the other accused of infringement) suffer backflow into the waveguide during self-cleaning. (App. B35-B36).

Accordingly, the District Court held the patent invalid as lacking utility under 35 U.S.C. §§ 101 and 112.

The Trial

The District Court found that the case was tried by Roper on the theory of

operation set forth in the patent, namely, (1) that backflow into the waveguide caused by autoignition pressures arising during self-cleaning was a serious problem in self-cleaning and (2) that backflow is, indeed, prevented by the oven described in the patent. (App. B44).

This was based directly on Roper's opening statement (App. B148-B149, B150-B151) and on the inventor's own testimony (e.g., Ap. B152-B153). The inventor testified that the patent was explicitly directed to solving the problem of backflow of oven vapors into the waveguide (App. B154-B155); that the consequences of allowing such backflow were extremely serious (App. B156, B157, B140-B141); and that the oven would not function effectively without an effective means for preventing backflow into the

waveguide during self-cleaning (App. B158).

The inventor claimed to have solved a "dilemma" posed by the prior art (App. B159, B160-B161) by placing the waveguide at the bottom of the oven cavity to allow convected air to pass through it during self-cleaning (App. B162-B166) as described in the patent (col. 7, lines 22-33).*

Roper asserted that autoignition backflow, and thus fouling, was thereby prevented, either because a counter-vailing back pressure was created by the convective air flow through the waveguide (App. B167) or simply because the air entry was limited and the waveguide

*Actually, as Triplett, Roper's Vice President of Engineering explained it, the waveguide was placed at the bottom of the oven because that was the most convenient and economical location because of the available space. (App. B136-B137).

formed a pressure chamber which prevented backflow from the oven (App. B168). In response to a direct question from the Court, the inventor represented that backflow was prevented by the convective air flow (App. B169-B172) and that this provided a positive resistance to autoignition back pressure (App. B173-B174).* Although he admitted the total implausability of this assertion because of its apparent violation of the laws of physics (App. B175-B177, B178-B179), he persisted in his assertion that his invention does prevent backflow and consequent fouling (App. B180-B181).

*By "resistance" the inventor testified that he meant sufficient resistance to prevent backflow (App. B154-B155, B167, B173-B174, B180-B181), which is the mechanism through which fouling allegedly occurs (App. B152-B153, B184-B191).

The District Court rejected this testimony and expressly found that the convected air can not and does not resist the autoignition pressure which gives rise to backflow (App. B35-B36), and thereupon invalidated the patent. (Id.).

Review by the Court of Appeals

In reversing the District Court as to claims 2-7, the Court of Appeals stated that the trial court "legally erred in interpreting claims 3 and 4" (App. B81), and erred as to claims 2 and 5-7 in finding that prevention of "explosive reactions", as specified in those claims, is equivalent to prevention of "autoignition" (App. B87-B88).

The Court of Appeals further ruled that claims 2-7 meet the utility requirements of § 101 because (1) the invention set forth in those claims (as

that court interpreted the claims) meets a single broadly stated objective of the invention (App. B91-B92); (2) claims 2-7, unlike claim 1, do not explicitly recite the stated objective of preventing backflow; and (3) the finding of infringement mandates a finding of utility. (App. B93-B95). The court also concluded that claims 2-7 were not invalid under § 112.

REASONS FOR GRANTING THE WRIT

I. The Decision Below Rests Upon an Erroneous Interpretation of a Prior Decision of this Court With Respect to the Nature of the Utility Required of Patentable Invention.

A. The Decision Below is Erroneous In Holding That an Invention Satisfies the Utility Requirements of 35 U.S.C. §§ 101, 112 If It Possesses Utility for Some Purpose Even if Such Purpose is Not the Purpose for Which the Patent was Granted.

The statutory requirements for utility are set forth at 35 U.S.C. §§101,

112. It has long been established in this Court that, in order to possess the requisite utility, an invention must be operable for its intended purpose, Mitchell v. Tilghman, 86 U.S. 287, 396, 397 (1873). The intended purpose is a question of fact or, at the very least, a mixed question of fact and law, to be determined from consideration of the patent specification, the statement of the problem to be solved, the description of the asserted solution, the state of the prior art and its relation to the invention in question, and other like factual questions. United States v. Adams, 383 U.S. 39 (1966); Mitchell v. Tilghman, supra.

In conflict with the decisions of this Court in Mitchell v. Tilghman, supra; O'Reilly v. Morse, 56 U.S. (15 How.) 62 (1853) and Beidler v. United

States, 253 U.S. 447 (1920), among others, the Court of Appeals in the instant case has held that an invention is "useful" within the meaning of the statute, 35 U.S.C. §§ 101, 112, if it can be used for any object stated in the patent specification (App. B91), whether or not that object has anything to do with the problem which the invention assertedly solved and for which the patent was granted.

To reach this result, it found, contrary to the express findings of the District Court based on all the evidence, that the invention was not an airflow structure that prevented backflow, as asserted by Roper, but simply an airflow structure that worked without exploding, whether or not it prevented backflow. In so construing the patent, and thus saving it from the invalidity that would

otherwise follow from the District Court's finding of complete and total inoperability, it dismissed the entire teachings of the patent, as well as the inventor's own damaging testimony as to it, as merely an erroneous "theory of operation". Further, it misconstrued the phrase "useable in all three modes" as wholly independent of the specifically stated purpose, i.e., an oven useable in all three modes without backflow, and thus fouling, in the self-cleaning mode.

The sole object which the Court of Appeals found "satisfied" by the invention as so redefined was one also met by every self-cleaning oven on the market prior to the time of the alleged invention, and every self-cleaning oven on the market since that time, including the prior art ovens (e.g., GE combination ovens) over which Roper claimed to have

made an advance. Every such oven has a ventilating system "useable in all three modes of operation", "safe in all three modes", and free of "risk of violent explosion of the products of combustion in the self-cleaning mode."

By thus disassociating the statutory command that an invention must be "useful" (35 U.S.C. § 101), from the purpose for which the invention must be useful (i.e., solution of the problem stated to be solved by the invention), the Court of Appeals departed from a consistent understanding of this Court as to the nature of the "utility" that an invention must possess to be patentable.

In O'Reilly v. Morse, 56 U.S. (15 How.) 62, 119 (1853) the requisite utility was specifically described:

> Whoever discovers that a certain useful result will be

> produced, in any art, machine, manufacture, or composition of matter, by the use of certain means, is entitled to a patent for it; provided he specifies the means he uses in a manner so full and exact, that any one skilled in the science to which it appertains, can, by using the means he specifies, without any addition to, or subtraction from them, produce precisely the result he describes. And if this cannot be done by the means he describes, the patent is void. (emphasis added)

And in Beidler v. United States, 253 U.S. 447, 453 (1920), the principle was similarly stated:

> Ever since Grant v. Raymond, 6 Pet. 218, 247, it has been consistently held that a correct and adequate description or disclosure of a claimed discovery (which, in the case of a machine, involves particularly the operation of it) is essential to the validity of a patent, for the reason that such a disclosure is necesssary in order to give the public the benefit of the invention after the patent shall expire... .
>
> The application of these requirements of the law to our conclusion that the only form of construction of the machine

> and the only method of operation of it which are disclosed in the patent would not produce a sufficiently uniform and rapid development of the film to render it useful, must result in the approval of the judgment of the Court of Claims, that the patent is invalid and void, for the reason that it fails to disclose a practical and useful invention. (Emphasis added).

The same principles were applied in Murton v. Ladd, Comr., Pats., 352 F.2d 942, 944 (D.C.Cir. 1965) which held the sole asserted claim invalid as being too broad because "it is not limited to a structure essential to accomplish the advantage claimed for the invention". The dissenting opinion of Circuit Judge Burger in that case would have sustained the claim on the ground that there was expert testimony that one skilled in the art would construe claim 2 as necessarily directed to structure achieving the stated advantage. Thus, whether the

advantage assertedly provided by the invention was to be found in the specification or whether it was to be found in the claim, the court clearly held that the claim must be interpreted as directed to a structure providing that advantage and, if it could not be so interpreted, it is invalid.

B. The Decision Below Is Erroneous In Holding That the Utility of an Invention to Solve the Problem Posed in the Patent is Not to Be Considered In Construing a Claim of the Patent Unless That Utility Is Expressly Stated in Such Claim.

In holding that a patented invention need not possess the utility asserted for it in the specification, the Court of Appeals confined Mitchell v. Tilghman, 86 U.S. 287 (1873) to cases where the asserted utility is expressly set forth in the claims. (App. B90-B91). Accordingly, it affirmed the District

Court's invalidation of claim 1, which expressly set forth the performance purportedly achieved by the invention, namely, convected air flow uninterrupted by backflow:

> ...so that when the blower and magnetron are turned off and the thermal element is turned on air is thermally convected from the blower inlet through the air passages into the waveguide and into the cavity for exiting through the cavity air vent...(Claim 1, Col. 11, lines 41-45)

even in the presence of autoignition:

> ...notwithstanding the autoignition pressure which exists in the cavity under high temperature self-cleaning conditions...(ibid., lines 45-48).

However, the Court of Appeals reversed the District Court's finding of invalidity as to claims 2 - 7 solely on the ground that those claims did not expressly recite that performance. (App. B91-B92), even though all of the claims

do in fact define essentially the same structure (see App. A14-A16):

> ...the blower inlet being located at a leve[l] below the bottom wall of the cavity... (Claim 1, col. 11, lines 39-41)

and, according to the patent specification (col. 7, lines 22-29), it is this very structure which provides the asserted performance.

1. The Standard Established by the Court of Appeals for Construing a Patent Ignores the Requirements of the Patent Statute Found in 35 U.S.C. § 112 and Contravenes Prior Decisions of This Court.

Section 112 of the patent statute, Title 35 U.S. Code, requires a written description (i.e., a "specification") of the invention that is sufficiently clear and concise as to teach those skilled in the art how to make and use the invention. This section also requires one or more claims defining what the inventor believes he has invented. The

most important task confronting any court in dealing with patent issues is defining just what that "invention" is and determining whether or not it meets the statutory standards.

The principle is well established in this Court that, in ascertaining the nature of an invention, one must construe not the claims standing alone, but, rather, the patent as a whole:

> ...it is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention.

United States v. Adams, 383 U.S. 39, 49 (1966)(emphasis added). To the same effect is Schriber-Schroth Co. v. The Cleveland Trust Co., 311 U.S. 211 (1940):

> The claims of a patent are always to be read or interpreted in the light of its specifications...(emphasis added).

In interpreting claims, resort must be had to the specification, even where the

claims, without such reference, would appear to read directly on the accused device. Graver Tank and Mfg. Co., Inc. v. Linde Air Products Co., 339 U.S. 605 (1950), stated that:

> Consideration must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function which it is intended to perform.

339 U.S. at 609 (emphasis added).

2. The Standard Established By The Court of Appeals for Construing A Patent Rewards and Encourages Sharp Patent Practice.

In addition to instructing those skilled in the art as to the nature of the invention and the manner of using it, the specification also serves to inform the patent examiner, who has the initial responsibility of determining patentability, as to just what the invention is. The examiner, as are the courts, is

required to consider "the specification as a whole". Application of Long, 368 F.2d 892, 895 (C.C.P.A. 1966). He is to interpret the claims in the light of the whole specification:

> Nor can we agree with appellants' position, that only Barrett's claims constitute evidence of what Barrett invented. It is true that appellants are correct in noting that it is the claims which define "the subject matter which the applicant regards as his invention." 35 USC 112 (second paragraph.) However, it does not follow from this that the specification should be ignored in determining what a patentee invented. To the contrary, it is a fundamental principle of patent law "that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966). [Emphasis added]

In re Clemens, Hurwitz and Walter, 622 F.2d 1029, 1037 (C.C.P.A. 1980).

Unless statements in the specification are wholly implausible on their face, if the examiner has no factual basis for rejecting them he must accept them at face value:

> As a matter of Patent Office practice, then, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of § 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

Application of Marzocchi, 439 F.2d 220, 223 (C.C.P.A. 1971).

Such statements are frequently given significant weight in assessing patentability:

> ...known disadvantages in old devices which would naturally

> discourage the search for new inventions may be taken into acount in determining obviousness.

United States v. Adams, 383 U.S. 39 (1966).

To hold, when interpreting the claims, that the patentee may tout such advantages in the specification as evidence of unobviousness, 35 U.S.C. § 103, in order to convince the Patent and Trademark Office to grant a patent, but may avoid being burdened by such assertions so long as they are not expressly incorporated into the claims, is to import into patent law the standards of Madison Avenue hucksterism: "Promise Her Anything, But Give Her Arpege". In particular, if this decision is allowed to stand, it will provide a clear message to patent applicants: one may, without facing any consequences, promise or represent anything in the

specification so long as one avoids sealing that promise into the claims.

The instant case is an excellent illustration of just such an occurrence. If the patentee had described only the structure of his oven, and had not asserted for it the unique ability to prevent backflow despite autoignition, his application would have been rejected by the Examiner under Anderson's-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57 (1969) as being a combination of old elements - a microwave oven and an electric self-cleaning oven - whose result is assuredly no greater than the sum of its parts. However, the patentee asserted the existence of a serious problem (fouling of an open waveguide due to backflow during autoignition) purportedly solved by the oven combination, even though he was aware of

the results of the Underwriters' Laboratories test at that time showing that the structure did not prevent backflow during self-cleaning (App. B28). The inventor even asserted at trial that he was "surprised" by the results and that he would not have believed it operated and, indeed, right through trial purported to be at a loss to understand how it did so.

The Examiner accepted the patent's assertions at face value, as he was bound to do, and allowed the application on the very first Office action without further examination. By omitting the asserted function of the invention from one or more of the claims of the application, and by including in the application a single general "object" of the invention that reads on any and every self-cleaning microwave oven ever placed on the market

before or since ("safe" and "useable in all three modes" without "risk of violent explosion"), the patentee has, unless this Court repudiates the doctrine announced by the Court of Appeals, thereby created an impregnable patent position for an "invention" that has never worked, never will, and is clearly substandard under under any rational criterion.

There is no basis here for sustaining any of the claims of the Roper patent.

II. In Holding That There Is Estoppel To Deny Utility Once Infringement is Found, The Court of Appeals Has Effectively Read 35 U.S.C. § 101 Out of the Patent Statute.

In Lehnbeuter v. Holthaus, 105 U.S. 94 (1881), the court considered a design patent on a merchandise showcase. After noting that the issuance of a patent is

prima facie evidence of both novelty and utility, and that neither presumption had been rebutted by the evidence, the court held:

> The fact that it has been infringed by defendants, is sufficient to establish its utility, at least as against them.

105 U.S. 94, 96, 97.

Whether in fact the court meant "utility" as now defined under 35 U.S.C. 101, 112 is open to question, since the concept has almost no meaning with respect to a design patent. Further, in stating that the presumption of novelty and utility had not in fact been rebutted by the evidence, the court clearly indicated that it had received and considered evidence on these points.

With the exception of a few cases in the Sixth Circuit, the theory of estoppel by infringement seems to have passed away

relatively unnoticed. Recently, however, it was resurrected by Judge Markey in E.I. DuPont De Nemours v. Berkley & Co., 620 F.2d 1247 (8th Cir. 1980) and again in the instant case.

From the manner in which the few courts treating the issue have applied it, the doctrine may well in fact be one of evidentiary weight, as opposed to estoppel. Thus, to the extent that the doctrine merely stands for the proposition that one who has been found to infringe will be treated with skepticism in asserting that the invention found to be infringed was without value, the doctrine would not appear to be improper and, in a given case, might be wholly appropriate. In such cases the assertion of "non-utility" is not an attack on utility vel et non but, rather, an attack on the degree or

amount of utility. In those cases, it is implicitly conceded by the infringer that the invention has some utility for its intended purpose (that is, that the invention is operable in the sense of 35 U.S.C §§ 101, 112) and the only dispute is as to the degree of usefulness.

In the instant case, in contrast, the dispute is not as to the degree of operability but, instead, as to the very question of whether there is any operability whatsoever. In particular, it was shown to the satisfaction of the District Court, to a degree that court characterized as "inescapable", that the patented airflow structure was wholly incapable of serving its intended purpose to any degree whatsoever, that is, it was wholly inoperable and thus lacked utility under 35 U.S.C. §§ 101, 112. In such a case, an estoppel to deny utility, i.e.,

operability, has no place in patent law, since the accused infringer is not deriving the asserted benefits of the invention.

To hold otherwise is to read the requirements of utility out of the law, since the only person having an interest sufficient to raise the question of utility after the patent is issued is an accused infringer. If no infringement is found, the question of utility need not be raised or, if raised, is not essential to decision. Only if infringement is found is it necessary to decide the question of utility, and it is precisely in that instance in which the Court of Appeals would estop the infringer to deny the utility.

It was this kind of situation tht led the Supreme Court, in Lear v. Adkins, 395 U.S. 653 (1969) to abolish the

doctrine of licensee estoppel. This Court ought not to countenance the creation of a new doctrine of estoppel to foreclose one accused of infringement from doing what the court in Lear found was essential to allow to those accused of infringement, namely, assert legitimate statutory defenses.

Moreover, the Court of Appeals' application of estoppel conflicts with Mitchell v. Tilghman, 86 U.S. 287 (1873), in which this Court considered the question of utility before dealing with infringement. The Court clearly, therefore, regarded the issue of utility as independent of , and unconstrained by, infringement considerations.

III. The Decision of the Court Below Establishes a Scope of Review of Findings of Fact of Such Breadth as to Be Essentially Unrestrained by Statute, The Federal Rules of Civil Procedure and Prior Decisions of This Court.

On the premise that the "invention" which is the subject of a patent grant is to be ascertained solely with reference to the claims (App. B84-B85), and that claim interpretation is strictly a question of law for the appellate court (id.), the Court of Appeals swept aside the findings and conclusions of the trial court regarding the nature of the patented invention and its meaning to one skilled in the art. It held this evidence to be totally irrelevant to the issue, and its review to be free of the "clearly erroneous" standard for evaluating findings of fact (App. B76-B78, B83-B85). Thus unfettered by the District Court's unquestionable findings, it then redefined the invention in a manner

contrary to the express teachings of the patent and to the testimony of the witnesses, including the inventor himself. In so doing, that Court turned away from nearly two centuries of precedent in this Court.

The mischief that will follow from this decision, if left standing, is not confined to this particular case. The Court of Appeals for the Federal Circuit is now the final authority for patent adjudication, save for this Court. The decisional principles it establishes in the field of patent law bind every court throughout the United States, subject only to review in this Court. The decision here effectively emasculates the role of the Trial Courts in patent cases. It makes the concept of the "trial" of a patent case nothing more than a "dry run" in preparation for argument before the

Court of Appeals and reduces the fact-finding role of the Trial Court to utter insignificance.

A. The Court of Appeals Erred in Disregarding the Trial Court's Findings As to the Nature and Mode of Operation of the Patented Invention.

Patent claims and specifications are addressed to those skilled in the art, 35 U.S.C. § 112, and testimony from such persons concerning the nature of the invention, its scope, Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 416 (1908), its mode of operation, and the manner in which it distinguishes from the prior art, Graham v. John Deere Co., 383 U.S. 1 (1966), is frequently helpful and sometimes essential. The weight to be given this testimony is a matter largely within the discretion of the trial court and trial

court findings based on that testimony are to be set aside only if they are "clearly erroneous". F.R. Civ. P. 52(a).

The trial court found that the invention related to the prevention of backflow and attendant waveguide fouling during self-cleaning (App. B35-B36, B44-B46). The solid evidentiary basis on which it made these findings is set forth above at pages 20-23.

Here, the Court of Appeals did not even purport to find that the trial court's findings as to the nature of the invention and its mode of operation (specifically, its utter <u>failure</u> to operate) were "clearly erroneous"; nor could it, in light of the overwhelming factual support on which these findings were based. Instead, that court merely dismissed those findings as <u>irrelevant</u> with respect to claim construction,

holding that "Claim interpretation is a legal matter subject to review free of the clearly erroneous standard applicable to fact findings." (App. B77). In support of this decision, it cited no authority other than its own prior recent holding to that effect.

This Court has recently reiterated the applicability of Rule 52(a) not only to what are frequently called "subsidiary" facts (in patent cases, such facts would be, for example: the state of the art at the time the invention was made, the level of skill in the art, and the manner in which the patented and accused devices operate), but also to so-called "ultimate" facts (in patent cases, these would comprise the questions of novelty, utility, and obviousness):

> Rule 52(a) broadly requires that findings of fact not be

> set aside unless clearly erroneous. It does not make exceptions or purport to exclude certain categories of factual findings from the obligation of a court of appeals to accept a district ccurt's findings unless clearly erroneous. It does not divide facts into categories; in particular, it does not divide findings of fact into those that deal with "ultimate" and those that deal with "subsidiary" facts.

Pullman-Standard v. Swint, 456 U.S. 273, 72 L.Ed.2d 66,79, 102 S.Ct. 1781 (1982). To the same effect is Graver Tank, supra, which specifically noted the especial applicability of Rule 52(a) to patent cases.

The Court of Appeals' total disregard of the District Court's findings in the instant case wholly contravened this standard. Regardless of who makes the "ultimate" findings, whether jury, trial court or appellate court, the subsidiary findings on which

the ultimate findings are based can be disregarded only if they are clearly erroneous.

The District Court's findings that the invention was asserted by Roper to be an oven useful in all cooking modes (thermal, microwave, and self-cleaning) which operated to expel decomposition products during self-cleaning operation (App. B28-B29) and, specifically, a ventilation system for such an oven which resisted backflow from autoignition and therefore prevented contamination of the waveguide (id.) were based not simply on reading the patent itself but were the inevitable result of the eight days of testimony before that Court. The trial court based these findings not only on the patent documents, but also on the positions taken by Roper and the testimony of Roper's witnesses:

> Roper seems to agree that the prevention of backflow and fouling is the key to the invention and submitted tests to show the patent was effective in accomplishing those objectives.

(App. B44) and

> According to Roper, there is no waveguide fouling because there is no backflow.

(App. B45).

Especially germane to the District Court's findings on these issues were the testimony of the inventor, as well as Roper's Trial Brief, Opening Statement, and Response to Raytheon's Request for Admissions.

The testimony of the inventor is set forth above at pages 20-23. Moreover, this characterization of the invention, and its asserted operation was consistent with the arguments of Roper counsel. In their trial brief, counsel expressly characterized "the problem" as pressure

surges caused by autoignition which can carry volatile decomposition products back from the oven cavity into the waveguide (App. B128-B130). The seriousness of allowing decomposition products into the waveguide was emphasized (id.). The "dilemma" this poses for the designer (giving up self-cleaning or risking dangerous contamination of the waveguide) was also asserted (App. B131).

Finally, as the solution to the "problem", Roper stated that the inventor found that by positioning the microwave feed system below the oven cavity and allowing natural convective air to flow through it during both thermal cooking and self-cleaning, the inventor found that the waveguide would not be fouled by "normal" autoignition pressures during self-cleaning (App. B162-B166). This was

asserted to come as a "complete surprise" to the inventor. (Ibid.).

Roper's opening statement repeated these assertions, arguing that the "fouling" which was to be prevented was that arising from backflow into the waveguide caused by autoignition. (App. B182, B183). And Roper's response to Raytheon's Request for Admission unequivocally asserted that in Roper's common cavity oven: "...such backflow is prevented, so that fouling does not occur, in normal self-cleaning even if autoignition does occur." (App. B135).

Thus the Court's finding as to the nature of the invention, and its operation were supported not only by substantial evidence but by overwhelming evidence. In fact, Roper even introduced at trial the results of tests it had run which it offered in support of its

assertion that its oven did not evidence backflow despite autoignition (App. B30).

In support of a contrary definition of the invention, the Court of Appeals ignored all this and pointed to but a single general "object" which it interpreted in a vacuum to find an "invention" having nothing to do with backflow (App. B91-B92). Further, The Court of Appeals suggested an apparent independence between backflow, on the one hand, and contamination or fouling of the waveguide, on the other (App. B85-B86); it purported to glean this independence solely from Roper's opening statement.

This is a far cry from the analysis of the trial record that the Court of Appeals should have undertaken to apply a "clearly erroneous" standard to the Trial Court's findings. Indeed, the evidence

provided by Roper itself compelled the District Court's findings.

B. The Court of Appeals Erred In Failing to Apply a Clearly Erroneous Standard To the District Court's Finding That Roper Tried the Case on the Basis of Backflow Prevention

In refusing to confine Roper to the basis it urged on the Trial Court, the Court of Appeals (App. B85-B86) clearly erred in rejecting the Trial Court's finding that Roper had tried the case on the basis of backflow prevention (App. B44). We have cited above only part of the Roper assertions and testimony to this effect. But even this provides more than ample support for the District Court's findings.

Accordingly, whether an appeal estoppel is imposed on Roper or the Roper trial case is taken as an admission, the result is the same: the nature of the

invention is supression of backflow and the patent claims, which are supposed to define the invention, must be construed accordingly. The claims are therefore all invalid for inoperativeness.

CONCLUSION

For the foregoing reasons, this Court should grant a Writ of Certiorari to review the judgment of the Court of Appeals for the Federal Circuit.

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